

Appl. No. 09/827,108
Response dated November 3, 2003
Reply to Office Action of August 5, 2003

REMARKS

This paper is responsive to the Office Action dated August 5, 2003. Claims 1-41 are pending, of which claims 2-5, 11-13, 15-20, 24, 26, 28-29, and 32-41 were withdrawn from consideration. Applicant respectfully traverses the withdrawal of claims 3-5, 12, and 16-18 from consideration. Applicant has amended the dependency of claims 3-5 and 16 so that they depend from either independent claim 1 or 14. This amendment serves to broaden the claims at issue and those that depend therefrom. As such, the claims correspond to the elected species and should be considered.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 6-10, 14, 21-23, 25, 27, 30, 31 under 35 U.S.C. 102(b) as being anticipated by Bonner et al. (US 5,902,331); rejected claims 1, 6-10, 14, 21-23, 25, 27, 30, 31 under 35 U.S.C. 102(e) as being anticipated by Langberg et al. (US 6,527,769); and rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by VandenEinde et al. (US 5,415,639).

Applicant respectfully traverses the rejection. Bonner et al., Langberg, et al., and VandenEinde et al. all fail to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(b), and provide no teaching that would have suggested the desirability of modification to include such features.

For example, Bonner et al. fails to teach or suggest an expandable fixation member coupled to the distal end of an elongated guiding device, as recited by Applicant's independent claim 1, 14, and 27. In fact, the Bonner et al. reference fails to mention use of an expandable fixation member, as expressly noted in the Background of the instant application at p. 6. Consequently, Applicant is entirely confused by the Examiner's interpretation of Bonner et al.

With regard to these elements of claim 1, the Examiner stated that Bonner et al. "teaches an expandable balloon" in paragraph 4 of the Office Action at p. 3. However, this passage of Bonner et al. describes a "balloon micro-catheter" which is used as a guiding means as a catheter is moved to a desired location. Contrary to the Examiner's assertion, Bonner et al. makes no mention of an expandable fixation member, as

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recited in Applicant's claim 1 and, as expressly noted in the Background of the instant application at p. 6.

Similarly, neither Landberg, et al. nor VandenEinde et al. teaches or suggests the use of an expandable fixation member coupled to the distal end of the elongated guiding device. Landberg et al. discloses an expandable member. However, this expandable member, to the extent that the Examiner may assert that it corresponds to a fixation member, is not coupled to the distal end of an elongated guiding device as recited by the independent claims. Finally, VandenEinde et al. teaches the use of a "single operator exchange balloon catheter." This catheter does not suggest an expandable fixation member coupled to the distal end of the elongated guiding device. Neither a fixation member nor a separate elongated guiding device is taught or suggested in VandenEinde et al.

In order to support an anticipation rejection under 35 U.S.C. 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."¹ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(b) is improper.²

Bonner et al., Landberg, et al., and VandenEinde et al. all fail to disclose each and every limitation set forth in independent claims 1, 14, and 27. Similarly, these three references all fail to teach or disclose each and every limitation from claims 6-10, 21-23, 25, 30, and 31, all of which depend from one of the above independent claims. For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 1, 6-10, 14, 21-23, 25, 27, 30, 31 under 35 U.S.C. 102(b). Withdrawal of this rejection is requested.

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

² *Id.* See also *Lewmar Marine, Inc. v. Bariant, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Respectfully submitted,

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